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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/728,099 | 12/01/2000 | Paul E. Jacobs | PA000385 | 4542 |

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| EXAMINER | |
|---|---|
| ALVAREZ, RAQUEL | |
| **ART UNIT** | **PAPER NUMBER** |
| 3622 | - |

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/728,099 | JACOBS ET AL. | |
| | Examiner | Art Unit | |
| | Raquel Alvarez | 3622 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *19 March 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

1. Claims 1-51 are presented for examination.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of copending Application No.09/728,693. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites means for performing the various steps. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the means for performing the various steps because such a modification would narrow the claims to include the particulars of the specification.

3. Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No.09/679,038. Although the conflicting claims are not identical,

they are not patentably distinct from each other because the instant application further recites that the communication link and the data communication link are separate communication links. Having 2 separate communication links one for communicating with the service provider and one for downloading the advertisements would avoid overloading and faster transmission. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the communication link and the data communication link are separate communication links in order to achieve the above mentioned advantage.

4. Claims 1-51 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40, 111-113 , 126-127, 136-137 and 146 of Application No.09/679,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application further recites that the communication link and the data communication link are separate communication links. Having 2 separate communication links one for communicating with the service provider and one for downloading the advertisements would avoid overloading and faster transmission. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have included the communication link and the data communication link are separate communication links in order to achieve the above mentioned advantage. Also the copending application further recites transmitting ad-statistical data. Calculating and transmitting statistical data it is old and well known in business in order to calculate and transmit statistical data in order to make educated assumptions and

statements on a particular subject. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included transmitting ad-statistical data in order to achieve the above mentioned advantage.

## ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 9-10, 15-17, 23-25, 27-30, 33-34, 41-48 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 1, 15, and 33, Marsh teaches a method for operating a client device that is configured for communications via a communications network (Abstract). Effecting an advertisement download communication link between the client device and an advertisement distribution server system, via the communications network, at selected advertisement download times (see figure 4 and col. 3, lines 28-37); effecting a data communication link with a data communications service provider, via the communications network, wherein the advertisement download communication link and the data communication link are separate communication links (Figure 4); downloading advertisements from the advertisement distribution server system via the advertisement download communication link (Figure 4); storing downloaded advertisements on a storage medium associated with the client device (col. 14, lines 1-

10); displaying at least selected ones of the stored advertisements, in accordance with ad display parameters prescribed by the advertisement distribution server system (Figure 6, 702).

With respect to claims 2, 16-17 and 45, Marsh further teaches that the method is installed on the client system and the advertisement distribution server system is controlled by a vendor of the software (col. 3, lines 12-56).

With respect to claims 3 and 49, Marsh further teaches that the communication network comprises the Internet (Figure 1 and col. 6, lines 16-29).

With respect to claim 4, Marsh further teaches that the software is subsidized by revenues attributable to the downloaded advertisements (col. 3, lines 66-, col. 4, lines 1-6).

With respect to claims 9-10, Marsh further teaches that the advertisements include main screen advertisements and toolbar advertisements (Figure 4).

With respect to claims 23-25, Marsh further teaches that the display parameters specify for each ones of the advertisements, how many times the advertisement is to be displayed for a given time period, and how long that advertisement is to be displayed each time that it is displayed (col. 3, lines 28-37).

With respect to claims 27-30, Marsh further teaches that the ad display

parameters specify, the total/cumulative amount of time that advertisements are to be displayed (col. 3, lines 28-37).

With respect to claim 34, Marsh further teaches generating a cookie containing information describing user/client device behavior and user demographics (col. 14, lines 66-, col. 15, lines 1-7); and transmitting the information to the at least one playlist server (Figure 8 and col. 15, lines 10-20).

With respect to claims 41-44, Marsh further teaches a playlist customized based on the user demographics and/or user device behavior col. 3, lines 12-27).

With respect to claims 46-48, Marsh further teaches that the software is e-mail Software (see Figure 8).

With respect to claim 50, Marsh further teaches that the display of the at least ones of the stored advertisements comprises displaying the at least selected ones of the stored advertisements when the client device is offline (col. 6, lines 63-, col. 7, line 1).

## ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5-8, 11-14, 18-22, 26, 31-32, 35-40 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (5,848,397 hereinafter Marsh).

With respect to claims 5-8, 11-12, 26, 31-32 and 51, Marsh further teaches the maximum time that the associated advertisements is to be displayed each time that it is displayed (col. 3, lines 28-37 and col. 14, lines 66-, col. 15, lines 1-20); the maximum cumulative time that the associated advertisement is to be displayed (col. 3, lines 28-37 and col. 14, lines 66-, col. 15, lines 1-20).

With respect to the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed. Official notice is taken that it is old and well known in advertisements/marketing to make certain determinations such as the maximum number of times per day that each stored advertisement is to be displayed and the date/time before which each stored advertisement is to be displayed and the end date/time after which each stored advertisement should not be displayed in order to target the correct time when the advertisements should be displayed and the right time that the advertisements should not be displayed in order to better target the correct time for the advertisements.

Claim 13 further recites displaying at least ones of the advertisements in a linear manner. Official notice is taken that it is old and well known to display in a linear manner in order to provide an output that is proportional. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included recites displaying at least ones of the stored advertisements in a linear manner in order to achieve the above mentioned advantage.

Claim 14 further recites displaying at least ones of the advertisements in a random manner. Official notice is taken that it is old and well known to perform a function at random in order to protect the data been transmitted. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included displaying the advertisements in a random manner in order to obtain the above mentioned advantage.

With respect to claims 18-22, 35-40, Marsh further teaches at least one of the ad display parameters is a face time duration parameter that specifies a face time duration for at least one of the stored advertisement (col. 3, lines 28-36) and the step of displaying at least selected ones of the stored advertisements comprises displaying the at least one of the stored advertisements for the face time duration prescribed by the associated face time duration parameter (col. 3, lines 28-36).
With respect to the face time duration comprising a time period during which at least a prescribed minimum level of user activity is detected. Since Marsh teaches maintaining

information on the user activity and interactivity with the advertisements (col. 14, lines 66-, col. 15, lines 1-7) then it would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using the user activity of Marsh to determine the face time duration of the advertisements during which at least a prescribed minimum level of the user activity is detected because such a modification would help in determining and better targeting the ads based on the user's activity.

***Point of contact***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/7/03